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CENTRAL FAX CENTER****JAN 09 2007****REMARKS**

Claims 1-8, 10-18, 38 and 40-44 are currently pending in the subject application.

In the Office action, the Examiner has rejected claims 1-8, 10-18, 38 and 40-44 under 35 U.S.C. §102(a) as being anticipated by PCT Application No. WO 00/072145 to Apfelbaum et al. The Examiner has also rejected claim 44 under 35 U.S.C. §103(a) as being unpatentable over the Apfelbaum et al. application in view of U.S. Patent No. 6,304,095 to Miyamoto.

Applicant submits that the Apfelbaum et al. application fails to show or suggest independent claims 1, 38 and 40 for at least the reasons set forth in Applicant's Amendment "A" filed on July 21, 2006. For purposes of brevity, Applicant will not repeat these reasons, but hereby incorporates them by reference. Applicant notes that the Examiner has failed to specifically address the points raised in Applicant's Amendment "A".

Applicant submits that the Miyamoto patent fails to cure (and is not cited as curing) the deficiencies of the Apfelbaum et al. application with regard to independent claim 40, from which claim 44 depends. Thus, Applicant submits that the pending claims are patentable over the Apfelbaum et al. application and the Miyamoto patent, individually and in combination.

Although Applicant will not repeat the arguments made in Amendment "A", Applicant will address the Examiner comments made in the final Office action.

In the Office action, the Examiner states that "the recitation '*using data representing test results for a plurality of transformers*' has not been given patentable weight because the recitation occurs in the preamble." The cases cited by the

Examiner do not support the Examiner's failure to consider the limitation. In fact, the **very language** cited by Examiner does not support the Examiner's failure to consider the limitation because the "*data representing test result...*" is recited in the body of independent claim 1 ! (A similar limitation is recited in the body of each of independent claims 38 and 40.) Thus, the limitation is unquestionably necessary for the completeness of the claims and does not merely recite purpose or intended use. "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Coming Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).

In the final Office action, the Examiner also states that "it is noted that the features upon which the applicant relies (i.e., a design for a device) are not recited in the rejected claims". Applicant does not understand this comment at all. Applicant recited the specific claim language that is not shown or suggested by the Apfelbaum et al. application. With regard to the Examiner's example of design for a device, it is respectfully noted that "**transformer design**" is specifically recited in independent claims 1, 38 and 40.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 050877.

Respectfully submitted,

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